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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

STL9760

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on October 26, 2005

Signature

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name

Diana C. Anderson

Application Number

09/894,668

Filed

June 27, 2001

First Named Inventor

Srinivas Tadepalli, et al.

Art Unit

2652

Examiner

Craig Renner

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 38,794

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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Date

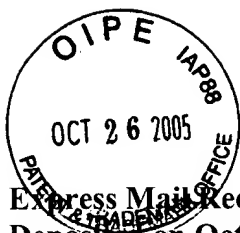
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PATENT
Dkt. STL9760

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Srinivas Tadepalli and Cory B. Welscher**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **09/894,668** Group No.: **2652**
Filed: **June 27, 2001** Examiner: **Craig Renner**
For: **DOWNSTREAM FINNED STRIPPER SHROUD AIRSTREAM**
CONDITIONING APPARATUS FOR A DISC DRIVE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Please enter the following remarks as Applicant's basis for this Pre-Appeal Brief Request for Review. Generally, this review is necessary and proper because the claims stand finally rejected, yet there remain unresolved issues leaving this case not in condition for appeal.

The Applicant is entitled to a patent unless the Examiner can by his examination substantiate a rejection based on the invention being previously patented or described (35 U.S.C. 102), or being otherwise unpatentable (35 U.S.C. 103). Although the Examiner is given the discretion to finally reject claims and thus close the merits, that discretion is premised in law upon the Examiner's obligation to make a complete examination with respect to the patentability of the invention as claimed. 37 C.F.R. 1.104(a). A final rejection based on an incomplete examination leaves the Applicant in a distinct disadvantage that is not contemplated by law, because the issues on appeal lack definition.

Below is an explanation of unresolved issues remaining from prosecution that make this case not in condition for appeal. First, the Examiner based final anticipatory rejections of independent claims 1, 15, and 20 on new grounds that clearly do not identically disclose all the recited features of the rejected claims. Applicant's rebuttal has improperly been characterized as raising new issues, which if upheld will wrongly mean that an incomplete examination can close the merits. Second, the Examiner finally rejected independent claim 15 as unpatentable without substantiating the requisite prima facie case of obviousness. Third, the Examiner has wrongly deemed independent claim 20 as not being a means-plus-function claim under Section 112 paragraph 6.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED
THE ANTICIPATORY FINAL REJECTION OF CLAIMS 1, 15, AND 20 IN RELATION
TO THE RECITED *AIRSTREAM STRIPPER* FEATURE

The Examiner asserted Schirle '545 in the final rejection as new grounds for anticipating the present embodiments as recited in independent claims 1, 15, and 20. **(Office Action of 7/26/2005, para. 8 and 15)** The Applicant rebutted the rejection on the basis that the cited reference cannot substantiate a Section 102 rejection for failure to identically disclose all the recited features of the rejected claims. Particularly, the Examiner's reading the *airstream stripper* onto Schirle '545's load/unload ramp is an unreasonably broad claim construction. The load/unload ramp 33 of Schirle '545 is not operably *downstream of the actuator* because it does not even extend over the data storage region, and it does not *attenuate the aerodynamic excitation*, but rather it creates turbulence in the area of the actuator. **(Office Action of 9/7/2005, ppg. 10-11)** Nevertheless, the Applicant attempted to obviate the rejection by more particularly pointing out and distinctly claiming the *airstream stripper* feature. **(Office Action of 9/7/2005, pg. 11)** The Examiner's reply was that

Applicant's argument and amendments raised new issues requiring further consideration.

(Advisory Action of 9/26/2005)

Thus, these claims stand finally rejected without the Examiner having substantiated a single anticipatory reference that identically discloses all the recited features of the rejected claims. The Examiner's citing new grounds in the final rejection cannot properly stand in the absence of a complete examination that substantiates an evidentiary basis for anticipation of all the recited features as claimed. Particularly, Applicant's lack of knowledge of the Examiner's basis for reading the *airstream stripper* onto a load/unload ramp leaves an unresolved issue from prosecution. To proceed with appeal leaves Applicant in the untenable position of appealing by its previous unresponded-to rebuttal, in the hope that knowledge of the Examiner's substantiation will eventually be disclosed. The Examiner is not justified in characterizing Applicant's rebuttal as raising new issues, when in fact it identifies unresolved issues preventing this case from being in condition for appeal.

The Examiner's final rejection fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R.

1.104(a). This unresolved issue must be addressed before this case is in condition for appeal.

**IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED
THE OBVIOUSNESS FINAL REJECTION OF CLAIM 15 BY THE REQUISITE PRIMA
FACIE CASE OF OBVIOUSNESS**

The Applicant rebutted the obviousness rejection of claim 15 over Hashizume '119 in view of Izumi '038 for lack of the requisite prima facie case of obviousness. **(Applicant's Amendment of 9/7/2005, ppg. 13-14)** Where the Examiner admits there is no motivation from the references to combine them to arrive at the present invention, the Applicant argued those teachings aren't enabling to the skilled artisan without undue experimentation. *In re*

Wright, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Furthermore, in the absence of express motivation, a statement that modifications of the prior art to meet the claimed invention would have been within the knowledge of a skilled artisan because all aspects of the claimed invention are individually taught by different references is not sufficient to substantiate the motivation or suggestion required by a bona fide prima facie case of obviousness. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Int. 1993); *In re Kotzab*, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999); MPEP 2143.01.

Arguing the merits of an asserted prima facie case of obviousness is a proper issue for appeal. However, here the Applicant is faced with proceeding to appeal in order to discover what the prima facie case is; such is not a proper issue for appeal. Without substantiating a bona fide prima facie case of obviousness, the Applicant bears no burden in furthering prosecution, because the Examiner's final rejection fails to satisfy the requirement of completeness with respect to the patentability of the invention that is dictated by 37 C.F.R. 1.104(a). This unresolved issue must be addressed before this case is in condition for appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS CONCLUDED THAT
CLAIM 20 IS NOT A MEANS-PLUS FUNCTION CLAIM UNDER SECTION 112
PARAGRAPH 6

If Applicant proceeds to appeal it is entitled to be in agreement with the Examiner as to whether claim 20 is properly construed as a means-plus-function claim. Applicant has repeatedly argued that claim 20 is in proper form as a means-plus-function claim under Section 112 paragraph 6. **(Applicant's Amendments of 1/31/2005 and 9/7/2005)** However, the Examiner has deemed claim 20 not to be a means-plus-function claim, for reciting sufficient structure in view of the prohibition against doing so in Section 112 paragraph 6.

The Applicant contends that the disputed claim language, *means for limiting the aerodynamic excitation resulting from air currents generated by the spinning disc*, in fact does not explicitly recite structure in any way preventing it from properly being construed under Section 112 paragraph 6 as a means-plus-function claim.

This dispute as to the form of claim 20, and as such the manner in which it will be construed on appeal, is an unresolved issue that must be resolved before this case is in condition for appeal.

Conclusion

Accordingly, for at least these reasons the Applicant believes this case is not in condition for appeal. Withdrawal of the final rejection of all claims for further prosecution on the merits to completion is respectfully requested.

Respectfully submitted,

By: _____



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